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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte JAMES A. KRISHER
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Appeal 2009-003833
Application 09/675,380
Technology Center 3700
_____

Decided: August 31, 2009
_____

Before MURRIEL E. CRAWFORD, ANTON W. FETTING,
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

JOSEPH A. FISCHETTI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§ 6(b) and 134(a) from the final

rejection of claims 68, 69, 71-77, 79-87, 90-92, 95,96, 98-104, 106-114, and

117-119. We have jurisdiction under 35 U.S.C. § 6(b). (2002).

Representative claim 68 reads as follows:

68. A computer readable medium comprising program instructions for
developing a reinsurance administration system for reinsurance contracts,
wherein the program instructions are computer-executable to implement a
method of:
    obtaining a reinsurance business process framework, wherein the
reinsurance business process framework comprises common functionality for

one or more reinsurance business processes and wherein the reinsurance business process framework comprises: one or more classes of objects designed for a reinsurance administration system; a plurality of support processes, a plurality of hook methods, and a designated order for executing steps in one or more application programs, wherein the steps comprise pre-execution, data entry, data validation, pre-commission, commission, and post-commission;

creating one or more reinsurance business process subclasses from the classes of objects of the reinsurance business process framework, wherein the one or more reinsurance business process subclasses inherit one or more of the hook methods of the reinsurance business process framework;

associating one or more of the support processes with one or more of the reinsurance business process subclasses;

overriding at least one of the hook methods of the reinsurance business process framework to access at least one stage in an execution of one of the reinsurance business processes and to identify a support process to be executed, wherein overriding the at least one hook method comprises overriding a method to be executed during data entry;

combining one or more reinsurance business process subclasses to build one or more application programs for the reinsurance administration system, wherein the order for executing steps in the one or more application programs is the order for the reinsurance business process framework;

creating one or more reinsurance contract objects that represent one or more reinsurance contracts, wherein creating a reinsurance contract object comprises:

identifying one or more inheritable contract objects from the class of objects to represent one or more conditions of a reinsurance contract, wherein the reinsurance contract object is a parent of a section object, and wherein the reinsurance contract comprises the transfer by a first insurer of at least a portion of the risk associated with a primary insurance contract to a second insurer to provide protection to the first insurer against the risk associated with the primary insurance contract;

creating an instance of the inheritable contract object to identify a condition object,

wherein the condition object is a child of the section object; and
configuring properties and methods of the condition object consistent with the
reinsurance contract;
    automatically generating reinsurance process objects as defined by the
combined reinsurance business process subclasses when one or more of the
application programs are initiated; and
    executing at least of the one or more application programs for the
reinsurance administration system.

    The references set forth below are relied upon as evidence of

unpatentability:

Copeland	5,946,694	Aug. 31, 1999
McCormack	6,049,773	Aug. 11, 2000
LeBlanc	6,694,506 B1	Feb. 17, 2004

    Pree, W. "Meta Patterns-A Means For Capturing the Essential of
    Reusable Object-Oriented Design"

    The Examiner rejected claims 68, 69, 71-77, 79-87, 90-92, 95,96, 98-
104, 106-114, and 117-119 under 35 U.S.C. § 103(a) as obvious over Leblanc
in view of Copeland, Pree, and McCormack. (Ans. 6)

    Each of independent claims 68 and 95 requires

… a designated order for executing steps in one or more application

programs, wherein the steps comprise pre-execution, data entry, data

validation, pre- commission, commission, and post-commission;…

combining one or more reinsurance business process subclasses to build one

or more application programs for the reinsurance administration system,

wherein the order for executing steps in the one or more application

programs is the order for the reinsurance business process framework;…

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and executing at least of the one or more application programs for the reinsurance administration system.

With regard to this limitation, the Examiner found that the "method would be performed the same regardless of whether the method had a specific type of framework support process, support process, or reinsurance framework. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability…." (Ans. 7).

Appellant maintains however that "… the steps including pre-execution, data entry, data validation, pre-commission, commission, and post-commission, as recited in claim 68, determines how the steps are carried out when the application program(s) are executed as part of the method." (Appeal Br. 9). Thus the steps are not non-functional descriptive material.

A review of the claim items in question, namely, *pre-execution, data entry, data validation, pre-commission, commission, and post-commission*, reveals that these items are not content, but action or process steps, e.g., entering data, validating data, etc. Moreover, these steps link the order for executing steps in the one or more application programs with the order for the reinsurance business process framework. Therefore, we agree with Appellant and cannot sustain the rejection of independent claims 68 and 95.

Since the remaining claims depend from either claims 68 and 95, and since we cannot sustain the rejection of claims 68 and 95, the rejection of the dependent claims likewise cannot be sustained.

The Examiner has also rejected claim 95 under 35 U.S.C. § 101 as failing to recite patent-eligible subject matter in that it does not recite a particular apparatus. (Ans. 4).

The test to determine whether a claimed process recites patentable subject matter under § 101 is whether: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 961-62 (Fed. Cir. 2008) (en banc).

We sustain the rejection of claim 95 under 35 U.S.C. § 35 U.S.C. § 101. Appellant argues that the preamble recites statutory subject matter in "[a] method for developing a reinsurance administration system for reinsurance contracts, the method comprising...." (Reply Br. 3).

We disagree with Appellant because the mere use of the word "system" does not necessarily connote an apparatus.[1] A system is generally defined as *a regularly interacting or interdependent group of items forming a unified whole*. Merriam Webster's Collegiate Dictionary Tenth Edition. Thus, a system could include items which abstractly define a business plan with the inclusion of an apparatus.

Even if one were to accept the word "system" recited in the preamble as patent-eligible, the body of the claim fails to incorporate it so as to breathe life and breath into the remainder of the claim. In other words, "if the preamble merely state[s] a purpose or intended use and the remainder of the claim completely defines the invention independent of the preamble," it does

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[1] We note that the Specification page 8 uses the terms "computer system 150" which would be patent eligible, as opposed to simply stating a system.

not constitute a limitation. *Lipscomb's Walker on Patents, 3rd Edition, Vol. 3,*
§ 11.11 at p. 361 (citing *Marston v. J.C. Penney Co.,* 353 F.2d 976, 986; *see
also, Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997); *Corning Glass Works
v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989) (An
element initially recited in the preamble, is thereafter fully incorporated into
the body of the claim so as to breathe life and breath into it by setting forth
the complete combination).

CONCLUSIONS OF LAW

We conclude Appellant has shown that the Examiner erred in rejecting
claims 68, 69, 71-77, 79-87, 90-92, 95,96, 98-104, 106-114, and 117-119
under 35 U.S.C. § 103(a) as obvious over Leblanc in view of Copeland, Pree,
and McCormack.

We conclude Appellant has not shown that the Examiner erred in
rejecting claim 95 under 35 U.S.C. § 35 U.S.C. § 101.

AFFIRMED IN PART

JRG

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